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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/763,231	01/26/2004	Keiichiro Ishihara	03500.017853.	6539
5514 7590 01/19/2007 FITZPATRICK CELLA HARPER & SCINTO 30 ROCKEFELLER PLAZA NEW YORK, NY 10112			EXAMINER TRAN, HUAN HUU	
			ART UNIT	PAPER NUMBER
			2861	

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	01/19/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary	Application No.		Applicant(s)	
	10/763,231		ISHIHARA, KEIICHIRO	
	Examiner		Art Unit	
	Huan H. Tran		2861	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 July 2006 and 10/25/06.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-73 is/are pending in the application.
- 4a) Of the above claim(s) 11-19 and 35-41 is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-10, 20-34 and 42-56, 57-73 is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>10/02/06</u> | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. The Petition under 37 C.F.R. § 1.144 filed on 07/28/06, seeking withdrawal of the requirement for election between species as entered in the Office Action dated March 20, 2006, and as made final in the Office Action dated June 26, 2006, is being treated as a request for reconsideration.

Upon careful review, the central argument made that the Office Action did not identify any specifically different embodiments that were described in the specification, that the allegedly different embodiments were "manufactured" from claim language is persuasive for the following reason:

First, it should be noted that original claims are part of the disclosure (MPEP 608.01(I) and 2163). A careful review of the specification reveals that claims 4 to 10, 28 to 34, 42, 43 and 49 to 56, said to read on elected embodiment but were withdrawn from consideration in the last Office action are fully described in the specification with respect to the first embodiment.

Accordingly, the previous election of species requirement is withdrawn in favor of the new election of species requirement which was previously proposed by applicant as follows.

In response to the argument made that the specification describes only seven different embodiments such that burden could not be established consistent with Applicant's prerogative to present a "reasonable number" of species, it should be noted that although 37 C.F.R. § 1.141(a) allows that more than one species of an invention, not to exceed a reasonable number, may be specifically claimed in different claims in one national application, it also requires that the application also includes an allowable claim generic to all the claimed species and all the claims to species in excess of one are written in dependent form (§ 1.75) or otherwise include

Art Unit: 2861

all the limitations of the generic claim. This requirement is simply not met in the instance application. There is no generic claim as stated in the previous Office Action.

In response to argument made that MPEP 808.02 -relied on in the Office Action to maintain its position that there would be burden -applies to restriction requirements, and not to requirements for elections between species. This argument is traversed for the reason the term "restriction" refers to either the usual restriction requirement or election of species. MPEP 802.02. Furthermore, as to species a requirement for restriction is permissible if there is a patentable difference between the species as claimed and there would be a serious burden on the examiner if restriction is not required. The criteria for burden is set forth in MPEP § 803 and § 808.02. See MPEP 808.01(a) which states:

"A requirement for restriction is permissible if there is a patentable difference between the species as claimed and there would be a serious burden on the examiner if restriction is not required. See MPEP § 803 and § 808.02."

Election/Restrictions

2. This application contains claims directed to the following patentably distinct species:

- (i) Species 1 represented by the first embodiment, illustrated in Figs. 1-6, 19-20.
- (ii) Species 2 represented by the second embodiment, illustrated in Fig. 7.
- (iii) Species 3 illustrated in Fig. 10.
- (iv) Species 4 illustrated in Fig. 11.
- (v) Species 5 illustrated in Fig. 13.
- (vi) Species 6 illustrated in Fig. 16.
- (vii) Species 7 illustrated in Fig. 18.

Art Unit: 2861

The species are independent or distinct because of the difference between the different embodiments as described in the specification. For instance, the differences between the different embodiments are described at page 52, lines 3-9; page 59, lines 13-25; page 63, lines 1-12; page 67, lines 9-17; page 73, lines 11-24; page 78, lines 18+.

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, no claim is generic.

Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which depend from or otherwise require all the limitations of an allowable generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

Applicant is advised that the reply to this requirement to be complete must include (i) an election of a species or invention to be examined even though the requirement be traversed (37 CFR 1.143) and (ii) identification of the claims encompassing the elected invention.

The election of an invention or species may be made with or without traverse. To reserve a right to petition, the election must be made with traverse. If the reply does not distinctly and specifically point out supposed errors in the restriction requirement, the election shall be treated as an election without traverse.

Art Unit: 2861

Should applicant traverse on the ground that the inventions or species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the inventions or species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the • evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

Claims 1-10, 20-34, 42-56 and newly added claims 57-73 are constructively elected as indicated in the response to the election of species filed on 04/20/06 and in the petition filed on 07/28/06. These claims are to be examined. Claims 11-19, 35-41 are withdrawn from consideration as being drawn to non-elected species.

Allowable Subject Matter

3. Claims 1-10, 20-34, 42-56, 57-73 are allowed.
4. The following is a statement of reasons for the indication of allowable subject matter:
Prior art of record including the art cited in the IDS filed on 10/02/06 do not teach or suggest a multi-beam optical scanning apparatus and an image forming apparatus using the same scanning apparatus with the claimed radiation order as recited in the independent claims. With the multiple radiation points arranged spaced apart from each other in the main scanning direction being excited in the claimed radiation order, synchronous detection of all the radiation points can be assured for the reason synchronous detection is executed when the **entire** light beam can be reflectively deflected by the deflecting means. The first and second radiation points can be determined for the reason that they are arranged spaced apart from each other in

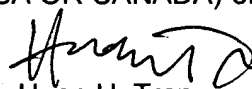
Art Unit: 2861

the main scanning direction at a predetermined distance from the deflecting means (rotational polygon mirror).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Huan H. Tran whose telephone number is (571) 272-2261. The examiner can normally be reached on at work on T-F from 6:30am to 5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Stephen Meier can be reached on (571) 272-2149. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.


Huan H. Tran
Primary Examiner
Art Unit 2861

hht
12/28/06